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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/983,605    05/01/98    RODER

M    2936.104/00

EXAMINER

HM12/0801

BUI, P

ART UNIT

PAPER NUMBER

1638

15

DATE MAILED:

08/01/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/983,605

Applicant(s)

Roder et al.

Examiner

Phuong Bui

Group Art Unit  
1638



☒ Responsive to communication(s) filed on May 10, 1900

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-4, 6-8, and 11-13 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 6-8, and 11-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1638

### DETAILED ACTION

1. The Office acknowledges the receipt of Applicant's Amendment E, Paper No. 13, filed May 10, 2000. In accordance with the interview of June 5, 2000, a restriction requirement is set forth below.

#### *Election/Restriction*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups I-XXIV. Claims 1-4, 6-8 and 11-13, drawn to microsatellite markers, classified in class 536, subclass 24.3.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I-XXIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. The microsatellite markers are structurally, chemically, and biologically distinct from each other.

4. Because these inventions are distinct for the reasons given above and the search required for one group is not required for any of the other groups, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Bruce Londa on June 5, 2000, a provisional election was made with traverse to prosecute the invention of I, claims 1-4, 6-8 and 11-13 to the extent of SEQ ID Nos. 1-20. Affirmation of this election must be made by applicant in replying to this

Art Unit: 1638

Office action. SEQ ID Nos: 21-466 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Accordingly, claims 1-4, 6-8 and 11-13 (to the extent of SEQ ID NO:1-20) are pending and are examined in the instant application.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-4, 6-8 and 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

Applicant states that the claimed microsatellite marker sequences are useful for the genetic analysis of the *Triticum aestivum* species. However, the claims lack a specific asserted utility and a well established utility because Applicant does not disclose what the markers are useful for, or how the genetic analysis obtained from using said markers would be useful. The markers may mark specific regions of the wheat chromosome but it is unclear where. It is unclear what the

Art Unit: 1638

microsatellite markers mark. While the markers may be useful for something, such as a marker for disease resistance, such a use is not substantial because Applicant does not disclose any specific markers having any such use, and to determine a utility for the markers would require a detailed analysis of the material obtained. Note, because the claimed invention is not supported by a specific asserted utility for the reasons set forth above, credibility cannot be assessed.

Claims 1-4, 6-8 and 11-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 112***

10. Claims 1-4, 6-8 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, in reference to the recitation of "A set of at least two microsatellite markers", it would appear that Applicant is referring to the primers as the satellite markers, which they are not. The primers simply flank the microsatellite markers. Thus, a set of at least two microsatellite markers would require at least four primer sequences. It is suggested that Applicant amends the claims to recite a microsatellite marker. Clarification and correction are required.

11. Claims 1-4, 6-8 and 11-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey

Art Unit: 1638

to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is claiming a set of at least two microsatellite markers which are defined by a pair of primers wherein each of said microsatellite markers is formed by amplification of the microsatellite sequence using PCR. Applicant is not claiming primer pairs. However, it is unclear that Applicant is in possession of the claimed microsatellite markers flanked by the recited primers. Applicant discloses the primers but it is unclear what region(s) of the wheat genome these primers flank. It is unpredictable what the claimed microsatellite markers are based upon Applicant's disclosure of the flanking primer sequences. Accordingly, Applicant's claimed invention lacks adequate written description (see June 15, 1998 Federal Register at Volume 63, No. 114, Pages 32639-32645).

### *Conclusion*

12. No claims are allowed. SEQ ID Nos. 1-20 are free of the prior art.

13. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 08/983605

Page 6

Art Unit: 1638

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
July 31, 2000

*P Bui*  
PHUONG T. BUI  
PRIMARY EXAMINER